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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,929	12/03/2003	Charles R. Bleich	247079-000214USP1	4684
70243 7590 05/12/2009 NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213				
EXAMINER OMOTOSHO, EMMANUEL				
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/726,929

**Applicant(s)**

BLEICH ET AL.

**Examiner**

EMMANUEL OMOTOSHO

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 71-79 and 91-112 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-79 and 91-112 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 74, 96, 104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, i.e. the microcontroller being associated solely with the game button, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the microcontroller is solely associated with the game button when it still needs to receive instructions from the gaming machine.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**4. Claims 71-79, 93-109 are rejected under 35 U.S.C. 102(e) as being anticipated by Jorasch et al. US Patent No. 7,267,614.**

5. Claims 71, 93, 102 and 109: Jorasch teaches A game button that receives selections related to a wagering game (abstract, fig 3, element 206 is being interpreted as a game button since it broadly reads on the game button) comprising: at least one variable display capable of presenting a plurality of images thereon (fig 3); and a memory communicatively coupled with the at least one variable display (abstract, fig 4), the memory adapted to store information for producing the plurality of images presented on the display (fig 4, abstract), the memory being associated solely with the game button and not another game button (fig 4). Detecting a player input via a sensor (i.e. a button) located within the button enclosure (col 7:21-31). The variable display and memory are mounted within a game button (fig 3). Game button is physically mounted on the gaming machine (broadly interpreting 'mount' to mean "to set or place", i.e. Jorasch game button could be physically set or placed on the gaming machine)

6. Jorasch fails to teach wherein the button is physically mounted on or within a gaming machine. Jorasch invention, when taken as a whole, shows a device that includes a display information which displays information related to a wagering game. To have this device attached to a gaming machine or physically within a gaming machine is an obvious design choice well within the skill set of one having ordinary skill in the art. Ivancic's invention (see figs 4-5) shows that one of ordinary skill in the art is more than capable of placing a device and its processor in a place that is generally subjected to physical "pounding" by the users.

7. Claims 72, 94, 103: wherein the stored information is utilized by the at least one variable display of the game button, and the memory does not allow the stored information to be accessed by another game button (col 6:65-col 7:10).
8. Claims 73, 95: wherein the at least one variable display is a liquid crystal display (col 6:47-53).
9. Claims 74, 96, 104: wherein the memory is included in a microcontroller also including a microprocessor, the microcontroller being communicatively coupled to the at least one variable display, the microcontroller being associated solely with the game button, the microcontroller controlling the presentation of the plurality of images on the at least one variable display (fig 4).
10. Claims 75, 97: wherein the microcontroller controls the presentation of the plurality of images on the at least one variable display associated with the game button and does not control the presentation of images on any display not associated with the game button (fig 4, col 6:65-col 7:10).
11. Claims 76, 98, 105: wherein the microcontroller is communicatively coupled to at least one controller selected from a group consisting of a gaming machine controller, a server controller, and a peer gaming machine controller (fig 5).
12. Claims 77, 99, 106: wherein the microcontroller communicates with the controller via a universal serial bus interface (col 8:5-14).
13. Claims 78, 100, 107: wherein the microcontroller is communicatively coupled to a server controller, the microcontroller presenting at least one image on the at least one

variable display in response to receiving a transmitted signal from the server controller (col 8:38-54).

14. Claims 79, 101, 108: wherein the plurality of images form a complex animation pattern (fig 3).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**16. Claims 71, 93, 102 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorasch et al. US Patent No. 7,267,614 and further in view of Neal, III US 2001/0036865.**

17. Claims 71, 93, 102 and 109: Jorasch teaches A game button that receives selections related to a wagering game (abstract, fig 3, element 206 is being interpreted as a game button since it broadly reads on a game button) comprising: at least one variable display capable of presenting a plurality of images thereon (fig 3); and a memory communicatively coupled with the at least one variable display (abstract, fig 4), the memory adapted to store information for producing the plurality of images presented on the display (fig 4, abstract), the memory being associated solely with the game button and not another game button (fig 4). Detecting a player input via a sensor (i.e. a button) located within the button enclosure (col 7:21-31). The variable display and memory are mounted within a game button (fig 3).

18. Jorasch fails to teach wherein the game button is physically mounted on the gaming machine. However, since the Jorasch button, which is in form of a token, comprises of a memory and a processor, it is possible for one of ordinary skill in the art to also use the game button as a mean of user authentication as described by Neal (par 84, 87). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the game button physically mounted on the gaming machine.

**12. Claim 110 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jorasch.**

13. Claim 110: Jorasch as shown above teaches all the present invention but fail to specifically teach a legend plate for displaying button game theme artwork to the player wherein the legend plate being mechanically coupled to the chassis. However, to have a legend plate for displaying button game theme artwork to the player wherein the legend plate is mechanically coupled to the chassis is truly up to the designer. This is a matter of design choice well within the skill set of one having ordinary skill in the art.

14. Claims 111-112: Jorasch teaches all of the present invention as shown above but fails to teach wherein the game button further comprising a plunger- spring assembly mechanically coupled to the chassis and in communication with the sensor, the plunger-spring assembly transmitting a linear motion to the sensor in response to being depressed by the player, wherein the sensor is selected from a group consisting of a micro-switch, a Hall-effect sensor, an optic sensor, an eddy current sensor, a resistive sensor, a piezo sensor, and a strain gage sensor. Spring biased sensor, micro-switch, a Hall-effect sensor, an optic sensor, an eddy current sensor, a resistive

sensor, a piezo sensor, and a strain gage sensor are all sensors well known in the art and thus are knowledge generally available to one of ordinary skill in the art. To choose between these well known type of input sensors is a matter of design choice well within the skill set of an ordinary skill artisan. Thus it would have been obvious to one having ordinary skill in the art to choose to have the game button further comprising a plunger-spring assembly mechanically coupled to the chassis and in communication with the sensor, the plunger-spring assembly transmitting a linear motion to the sensor in response to being depressed by the player, wherein the sensor is selected from a group consisting of a micro-switch, a Hall-effect sensor, an optic sensor, an eddy current sensor, a resistive sensor, a piezo sensor, and a strain gage sensor.

**15. Claims 71-79, 93-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ivancic US Patent No. 7,071,845**

16. Claims 71, 93, 102 and 109: Ivancic teaches a game button comprising: at least one variable display capable of presenting a plurality of images thereon (fig 3-4); and a memory communicatively coupled with the at least one variable display (fig 5, element 59), the memory adapted to store information for producing the plurality of images presented on the display (fig 5, col 5:8-45). Detecting a player input via a sensor (i.e. a button) located within the button enclosure (fig. 4). The variable display and memory are mounted within a game button (fig 4). Game button is physically mounted on the gaming machine (fig 4).

17. Ivancic's button is part of an enclosure attached to a computer or a phone device. Since computers and phone devices are known to execute gaming



applications, they are being interpreted as gaming machines. It is a matter of design choice well within the skill set of an ordinary skilled artisan to choose the type of gaming applications a particular gaming device will execute. A 'wagering game' application is well known in the art. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to have Ivancic button setup mounted on or within a gaming machine to receive selections related to a wagering game.

18. Claims 71-72, 93-94 and 102-103: Ivancic as modified above fails to teach a memory being associated solely with a game button. In figure 5, buttons on the same row shares the same buffer. However, it would have been obvious to one having ordinary skill in the art to include more memory units and have each memory unit associated with only one button since it has been held that duplication of parts (*St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8) and constructing a formerly integral structure in various elements (*Nerwin V. Erlichman*, 168 USPQ 177, 179) involves only routine skill in the art.

19. Claims 73, 95: wherein the at least one variable display is a liquid crystal display (col 4:36).

20. Claims 74, 96, 104: wherein the memory is included in a microcontroller also including a microprocessor, the microcontroller being communicatively coupled to the at least one variable display, the microcontroller being associated solely with the game button, the microcontroller controlling the presentation of the plurality of images on the at least one variable display (fig 4).

21. Claims 75, 97: Ivancic as modified above fails to teach wherein the microcontroller controls the presentation of the plurality of images on the at least one variable display associated with the game button and does not control the presentation of images on any display not associated with the game button. In figure 5, buttons on the same row shares the same microcontroller. However, it would have been obvious to one having ordinary skill in the art to include more microcontroller units and have each microcontroller unit associated with only one button since it has been held that duplication of parts (*St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8) and constructing a formerly integral structure in various elements (*Nerwin V. Erlichman*, 168 USPQ 177, 179) involves only routine skill in the art.

22. Claims 76, 98, 105: wherein the microcontroller is communicatively coupled to at least one controller selected from a group consisting of a gaming machine controller, a server controller, and a peer gaming machine controller (fig 5).

23. Claims 77, 99, 106: Ivancic fails to teach wherein the microcontroller communicates with the controller via a universal serial bus interface. However, universal serial bus interface is a well known and accepted communicating interface to communicate data between devices/controllers. It would have been an obvious design choice well within the skill set of an ordinary skill artisan to have the microcontroller communicate with the controller via a universal serial bus interface.

24. Claims 78, 100, 107: wherein the microcontroller is communicatively coupled to a server controller, the microcontroller presenting at least one image on the at least one

variable display in response to receiving a transmitted signal from the server controller (fig. 5 ).

25. Claims 79, 101, 108: wherein the plurality of images form a complex animation pattern (fig 4).

26. Claim 110: Ivancic as shown above teaches all the present invention but fail to specifically teach a legend plate for displaying button game theme artwork to the player wherein the legend plate being mechanically coupled to the chassis. However, to have a legend plate for displaying button game theme artwork to the player wherein the legend plate is mechanically coupled to the chassis is truly up to the designer. This is a matter of design choice well within the skill set of one having ordinary skill in the art.

27. Claims 111-112: Ivancic teaches all of the present invention as shown above but fails to teach wherein the game button further comprising a plunger- spring assembly mechanically coupled to the chassis and in communication with the sensor, the plunger-spring assembly transmitting a linear motion to the sensor in response to being depressed by the player, wherein the sensor is selected from a group consisting of a micro-switch, a Hall-effect sensor, an optic sensor, an eddy current sensor, a resistive sensor, a piezo sensor, and a strain gage sensor. Spring biased sensor, micro-switch, a Hall-effect sensor, an optic sensor, an eddy current sensor, a resistive sensor, a piezo sensor, and a strain gage sensor are all sensors well known in the art and thus are knowledge generally available to one of ordinary skill in the art. To choose between these well known type of input sensors is a matter of design choice well within the skill set of an ordinary skill artisan. Thus it would have been obvious to one having

ordinary skill in the art to choose to have the game button further comprising a plunger-spring assembly mechanically coupled to the chassis and in communication with the sensor, the plunger-spring assembly transmitting a linear motion to the sensor in response to being depressed by the player, wherein the sensor is selected from a group consisting of a micro-switch, a Hall-effect sensor, an optic sensor, an eddy current sensor, a resistive sensor, a piezo sensor, and a strain gage sensor.

#### **Pertinent Prior Arts**

28. Prior arts deemed pertinent but not relied upon:
- a. Snyder et. al. US 4, 749,878 – Shows Input device using spring biased pressure sensor
  - b. Berman et al. US 5,669, 921 – Shows the use of input sensors such as optic sensors, hall effect sensors, switch sensors, and eddy sensors.

#### ***Response to Arguments***

29. Applicant's arguments filed 4/20/09 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMMANUEL OMOTOSHO whose telephone number is (571)272-3106. The examiner can normally be reached on m-f 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO

/Ronald Laneau/

Primary Examiner, Art Unit 3714

05/08/09